UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,492	11/14/2001	Teresa Barbara Crook	CM2045F	8062

27740 7590 07/05/2002

THE PROCTER & GAMBLE COMPANY
PATENT DIVISION
SHARON WOODS TECHINICAL CENTER
11511 REED HARTMAN HIGHWAY
CINCINNATI, OH 45241

EXAMINER
YU, GINA C

ART UNIT	PAPER NUMBER
1617	8

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,492	CROOK ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not enable a skilled artisan to determine without undue experimentation "a safe and effective amount" of *the mixture* of vitamin B3 compounds and retinoids for chronic use. The disclosure does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with this claim.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 9, the phrase "a whole number multiple thereof" renders the claim vague and confusing.

The remaining claims are rejected as depending on indefinite base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al. (US 5690916) ("Kimura") and Dietz et al. (US 6132873) ("Dietz") and JP 57098205 A ("Pola abstract").

Kimura teaches skin-color adjusting composition comprising 5.0 % by weight of titanium-coated mica which have transmitted interference color green; 9.0 % by weight of titanium dioxide treated with silicone; and 5.0 % by weight of globular nylon powder. See Example 8; instant claim 3. See also Example 9 and 11. The reference teaches that emulsion-type, water-dispersed, and oil-dispersed foundations are conventional cosmetic formulations in which pigments are used. See col. 1, lines 20 – 29; instant

claim 13. The method of applying the composition to the skin to even the skin-tone is an obvious use of the invention. See instant claims 13-17.

While Kimura teaches different weight range of the interference pigments and inorganic powder, differences in the concentration of the actives in general will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Kimura, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Lowering the amount of the interference pigments also is viewed economically advantageous from the perspective of a manufacturer, or an obvious optimization to match the desired shade or intensity of the color.

Kimura fails to disclose interference pigments having titanium dioxide layer of 120 nm – 160 nm.

Dietz teaches multilayered interference pigments useful for cosmetic applications. Col. 1, line 55 – col. 2, line18. The reference teaches that the thickness of the layers of metal oxides of high refractive index (e.g., titanium dioxide, as illustrated in Example) is preferably between 40 and 260 nm. See col. 3, lines 52 –67. Dietz further suggests that "a skilled worker is able readily, by altering the layer thickness, to prepare a pigment" with a desired color and intensity. See col. 4, line 25 – 36. An interference pigment according to the invention with intense green color is disclosed in Example. Dietz further teaches that, due to the incorporation of the interlayer of a low-refractive-index metal oxide, the pigments of the invention provide improved mechanical stability,

brighter colors and greater intensity of the colors than previously known interference pigments. See col. 4, lines 36 – 44.

While Kimura uses "globular nylon powders", both Kimura and Dietz fail to teach porous nylon particles.

Pola abstract teaches cosmetics comprising spherical powder of porous resin, such as nylon, having average particle size 2-20 microns. See Abstract; instant claims 9 and 10. The abstract teaches that the porous powders are used in face powder or emulsion foundation, and provide "prolonged cosmetic activity, good touch, high transparency, and high compatibility with skin". While the abstract does not disclose the refractive index of the porous nylon powder, examiner takes the position that the claimed physical characteristic must be also necessarily present in the prior art which otherwise has same or overlapping limitation as the nylon powder used in the instant invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the cosmetic composition in Kimura by substituting the interference pigments with the interlayered pigments as taught by Dietz, because of the expectation of successfully producing an improved skin-color adjusting composition with stability, brighter color and greater intensity of the colors. The skilled artisan would have been further motivated to substitute the spherical nylon powder with the spherical porous powder as suggested by Pola abstract because of the expectation of successfully producing a cosmetic composition which provide longer cosmetic activity

and good skin feel, and yet do not alter the coloring effect of the pigments in the composition.

2. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura, Dietz, and Pola abstract, as applied to claims 1-3 and 9-17 above, and further in view of Nishimura et al. (JP 410194944 A, English abstract of JP 10194944 A) ("Nishimura") and Mathur (US 4096240).

Kimura and Dietz, discussed above, fail to teach the skin condition actives recited in the instant claims.

Nishimura teaches using anatase type titanium dioxide as an ultraviolet light-protecting agent in cosmetics. See abstract.

Mathur teaches skin lightening composition comprising niacinamide. See abstract. The reference suggests employing from about 0.1-10 % of the active. See col. 1, line 66 – col. 2, line 30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding or substituting the matting agent therein with anatase titanium dioxide, as motivated by Nishimura, because of the expectation of successfully enhancing ultraviolet light protection of the skin. The skilled artisan would have been further motivated to add niacinamide as suggested by Mathur because of the expectation of successfully producing a skin-color adjusting cosmetic composition with skin-lightening effect.

All components in the instant invention are well known. Nothing nonobvious or unexpected is seen in combining the conventional ingredients well known in cosmetic art. See MPEP 718.02.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 29, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200